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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,979	10/02/2003	Stephen D. Pacetti	50623.340	1567

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EXAMINER	
EDWARDS, LAURA ESTELLE	
ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/678,979	PACETTI ET AL.	
	Examiner	Art Unit	
	Laura Edwards	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-53* is/are pending in the application.

4a) Of the above claim(s) *18-45* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *46-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

This application contains claims 18-45 drawn to a non-elected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 46-53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,695,920 for reasons mentioned in the previous office action. Even though new claims 52 and 53 designate a center gear axis offset from a center stent axis, both the present application and patent remain to claim the same inventive concept to a mandrel having a gear support thereon to support a stent for coating. More specifically, the limitations of claim 7 of US 6,695,920 with respect to the gear having a shape or diameter configured so that its contact area changes location as the stent is rotated obviously encompasses the present limitation as set forth both in claims 52 and 53

including the gear having a center gear axis offset from the center stent axis. The offset gear axis would enable the gear to contact different areas of the inner surface of the stent as the stent is rotated during the coating process.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 51 is rejected under 35 U.S.C. 102(e) as being anticipated by Taylor et al (Us 6,214,115).

Taylor et al provide a stent supporting device comprising a metal mandrel or support (3) for extending through a stent during a coating of the stent and at least one protrusion or gear (15) made of plastic or ceramic material having apertures therein for placement along the mandrel for supporting the stent during coating.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwin et al (US 6,245,099) in view of Leidner et al (US 6,056,993).

Edwin et al teach a stent mounting device comprising a mandrel (20) for extending through a stent and at least one protrusion or gear (22; see col. 12, lines 37-57) having a diameter greater than a diameter of the mandrel and positioned thereon to support and contact an inner surface of the stent while the protrusion or gear is made of a material capable of providing sufficient torque for enabling rotation of the stent during coating. Even though Edwin et al recognize that the mandrel is turned (see col. 11, lines 36-39), Edwin et al are silent concerning the use of a rotational device for rotating the mandrel and a stent thereon during a coating process. However, it was known in the art, at the time the invention was made, to provide a rotational device connected to a mandrel for holding a stent to enable coating or treating about the circumference of the stent body as evidenced by Leidner et al (see col. 5, lines 52-60). It would have been obvious to one of ordinary skill in the art to provide a rotational device as taught by Leidner et al in communication with the mandrel of Edwin et al in order to impart rotation to the stent body during manufacture.

With respect to claim 50, Edwin et al teach a mandrel having a gear as mentioned above but Edwin et al are silent concerning the gear being supported on the mandrel and designed so as to allow for a spacing between a majority of an outer periphery of the gear and an inner surface of the stent. However, it is well established in the art of stent manufacture that mandrels can take

on different diameters as evidenced by Leidner et al (see col. 5, lines 60-67). In light of the teaching by Leidner et al, that the mandrel can change in size or diameter, it would have been within the purview of one skilled in the art to provide a smaller diameter mandrel having a smaller diameter gear so as to result in a spacing between an outer periphery of the gear with respect to the inner surface of a given stent.

Response to Arguments

Applicants arguments filed 12/8/04 have been fully considered but they are not persuasive.

Applicants contend that Taylor et al do not teach a gear adjustably supported by the mandrel. This argument is not deemed persuasive because Taylor et al recognize placement of at least one protrusion or gear (15) on a mandrel as shown in Fig. 1. The protrusion or gear is placed thereon by the user as evidenced by the other mandrels having no protrusion or gear. Applicants' claim as broadly read does not require the protrusion (15) to have teeth or even require its movement. According to dictionary definition of the term "gear", any tool used for a particular activity can be deemed a gear (see attached dictionary definition). Claim 51 therefore remains unpatentable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laura Edwards
Primary Examiner
Art Unit 1734

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March 3, 2005